

**RESPONSE UNDER 37 C.F.R. § 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 3735  
PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: Kaplan, Richard                      DOCKET NO: 086524-0010US  
SERIAL NO.: 10/790,885                      ART UNIT: 3735  
FILED: March 1, 2004                      EXAMINER: Colquitt, Aaron Bruce  
CONF. NO.: 2598  
TITLE: AUTOMATED INSOMNIA TREATMENT SYSTEM

**AMENDMENT AFTER FINAL OFFICE ACTION OF JULY 8, 2008  
PURSUANT TO 37 C.F.R. § 1.116. EXPEDITED PROCEDURE  
EXAMINING GROUP 3735**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

This amendment presents limitations to the claims and arguments touching the merits of the present application intended to place the application in condition for allowance or in better form for appeal.

Applicants' system for treating insomnia (essentially difficulty in falling asleep) currently stands rejected as obvious based on an alarm clock (for gently waking up people not identified as having sleep difficulties) fitted with an insomnia monitoring device that provides no data related in any way to the operation of the alarm clock. This rejection is directly at odds with *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1724, 82 U.S.P.Q. 2<sup>nd</sup> 1385 (2007), which expressly noted that obviousness cannot be proven merely by showing that alleged elements of a claimed device were known in the prior art. Rather, it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." *Id.* at 1741. The current Office Action (and its predecessor) fails to meet this requirement.

**Amendments to the claims** begin on page 2 of this paper.

**Remarks** begin on page 10 of this paper.